

REMARKS

On pages 3-4 of the Decision On Appeal dated July 12, 2005, the Board construes Appellants' claims to encompass a human that is infected with HIV-1. Based on the Board's construction of the claims, the Board appears to have raised a new ground of rejection on pages 7-8 of the Decision by stating that "the evidence of record indicates that these **methods were prior art methods** not inventive to appellants" and "the claims **include within their scope the natural process** of raising antibodies when an individual is infected by HIV-1." Although the Decision did not use the term "rejection," the Board nonetheless appears to have raised a new ground of rejection under 35 U.S.C. § 101 and/or § 102, of Appellants' claims over a "natural process" or "prior art." See 37 C.F.R. § 41.50(b).

If, in fact, the Board has raised a new ground of rejection, Appellants request, pursuant to 37 C.F.R. § 41.50(b), that this Amendment be entered and prosecution reopened. Since 37 C.F.R. § 41.50(b) appears to treat the filing of an Amendment as an alternative to filing a Request for Rehearing, it is Appellants' understanding that both a Request for Rehearing **and** an Amendment cannot both be filed. If this is the case, and the Board has raised a new ground of rejection, Appellants request that this Amendment be entered and that the accompanying Request be disregarded. Alternatively, if the Board has not raised a

new ground of rejection, Appellants request that this Amendment be disregarded.


Appellants have amended claims 34-36 in response to the Board's apparent raising of a new ground of rejection that "the evidence of record indicates that these **methods were prior art methods** not inventive to appellants" and "the claims **include within their scope the natural process** of raising antibodies when an individual is infected by HIV-1." The Board's position is based on its construction of the claims to encompass a human that is infected with HIV-1. The amendment of claims 34-36 inserts the term "recombinant," which is supported, for example, on page 13, line 29, of Appellants' specification. The amendment also inserts the phrase "by using the antigen as an immunogen," which is supported, for example, on page 14, line 2, of Appellants' specification. This amendment highlights that Appellants' process does not encompass a human that is infected with HIV-1, but requires active manipulative steps of providing a recombinant antigen and using the antigen as an immunogen. Appellants submit that the amendment obviates the new ground of rejection.

Please grant any extensions of time required to enter this paper and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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